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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

William J. BAER, et al.

Appln. No.: 09/488,969

Confirmation No.: 5170

Filed: January 21, 2000

Docket No: A8520

Group Art Unit: 2176

Examiner: Maikhanh NGUYEN

For: PREREQUISITE CHECKING IN A SYSTEM FOR CREATING COMPILATIONS OF CONTENT

SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. A check for the statutory fee of $500.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,

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WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: June 28, 2005

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
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Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

Table of Contents

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is International Business Machines Corporation ("IBM") of Armonk, New York, the assignee.

II. RELATED APPEALS AND INTERFERENCES

The following applications are the subject of a prior or pending appeal, are related to the present application on appeal, and may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

- U.S. Application No. 09/489,143: Notice of Appeal filed June 2, 2005;
- U.S. Application No. 09/489,561: Notice of Appeal filed January 18, 2005; finality of the rejections was withdrawn and a Notice of Allowance mailed on April 27, 2005.
- U.S. Application No. 09/489,605: Notice of Appeal filed January 22, 2005; finality of the rejections was withdrawn and a Notice of Allowance mailed on April 27, 2005.

There are no other appeals or interferences known to Appellant, Appellant's legal representative, or the assignee that will directly affect or be directly affected by, or have a bearing on, the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-15 are pending in the present application and stand rejected. The rejection of each of these claims is being appealed.

Claims 1, 6 and 11 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,592,628 to Prinzing.

Claims 2-5, 7-10 and 12-15 are rejected under 35 U.S.C. § 103(a) as being anticipated by Prinzing in view of U.S. Patent No. 6,351,752 to Cousins *et al.* A copy of the claims on appeal is set forth in an attached Appendix.

IV. STATUS OF AMENDMENTS

The status of any amendment filed subsequent to the final rejection of January 4, 2005, is as follows: A Response under 37 C.F.R. § 1.116, in which no amendments were made, was filed on March 4, 2005, in response to the Final Office Action dated January 4, 2005. In an Advisory Action dated March 28, 2005, the Examiner states that the Response was considered but did not place the application in a condition for allowance.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellant's invention as recited in, for example, independent claims 1, 6 and 11, is related to methods, program storage devices, and systems for providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data repository.

Content management systems such as relational databases, digital libraries, and media servers have enabled contents of all types to be stored digitally. Content management systems also have functions for manipulating the stored content. An exemplary embodiment of the present invention permits a user to take advantage of vast stores of content to create compilations tailored to the user's needs or desires. See page 1 of Applicant's specification.

Claim 1

A method for providing prerequisite checking in a system (see pages 4, line 28-page 5, line 2 of Applicant's specification) for creating compilations from a plurality of content objects stored in a data repository (Fig. 1, digital library 20), each content object comprising a plurality of content entities (see page 99 of Applicant's specification), some of the content entities being prerequisites to others of the content entities (see pages 71 and 103 of Applicant's specification), comprising the steps of upon addition or removal of a content entity to or from the compilation, determining if the content entity has any prerequisite content entities, and if so, adding or removing the prerequisite content entities. (Id., see also, Figs. 1-7, 23 and 24).

Claim 6

A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform method steps for providing prerequisite checking in a system (see pages 4, line 28-page 5, line 2 of Applicant's specification) for creating compilations from a plurality of content objects stored in a data repository (Fig. 1, digital library 20), each content object comprising a plurality of content entities, some of the content entities being prerequisites to others of the content entities (see page 99 of Applicant's specification), comprising the steps of upon addition or removal of a content entity to or from the compilation, determining if the content entity has any prerequisite content entities (see pages 71 and 103 of Applicant's specification), and if so, adding or removing the prerequisite content entities. (Id., see also, Figs. 1-7, 23 and 24).

Claim 11

A system for providing prerequisite checking in a system (see pages 4, line 28-page 5, line 2 of Applicant's specification) for creating compilations from a plurality of content objects stored in a data repository (Fig. 1, digital library 20) each content object comprising a plurality of content entities (see page 99 of Applicant's specification), some of the content entities being prerequisites to others of the content entities, comprising means for determining (see page 71, function ECBOAddContent, functional processing step 7a-f; Fig. 1, reference numerals 28 and 30), upon addition or removal of a content entity to or from the compilation, if the content entity has any prerequisite content entities (see page 103 of Applicant's specification), and if so, adding or removing the prerequisite content entities. (Id., see also, Figs. 1-7, 20A, 20B, 23 and 24).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 6 and 11 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Prinzing (U.S. Patent No. 6,592,628).

2. Claims 2-5, 7-10 and 12-15 have been rejected under 35 U.S.C. § 103(a) as being anticipated by Prinzing in view of Cousins *et al.* (U.S. Patent No. 6,351,752).

VII. ARGUMENT

1. Claims 1, 6 and 11 are patentable over Prinzing

As noted above, claims 1, 6 and 11 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Prinzing. It is respectfully submitted that claims 1, 6 and 11 are patentable over Prinzing for at least the following reasons.

Claims 1, 6 and 11

Claim 1 recites:

"A method for providing **prerequisite checking** in a system for creating **compilations** from a plurality of content objects stored in a data repository, each content object comprising a plurality of content entities, some of the content entities being **prerequisites** to others of the content entities comprising the steps of: upon addition or removal of a content entity to or from the compilation, determining if the content entity has any **prerequisite content entities**, and if so, adding or removing the **prerequisite content entities**."

In the prerequisite checking of claim 1, if a content entity is added to or removed from the compilation, it is determined whether any other content entity must be present as a prerequisite to adding/removing the content entity. For example, if a content entity A is a prerequisite of a content entity B, the addition of content entity B to the compilation will, through prerequisite checking, result in adding content entity A to the compilation.

Prinzing does not disclose these features of claim 1. Rather, Prinzing is directed to a document entity that uses element entities to represent the structure of text without the content of

the text and a separate document entity that contains the content of the text. Col. 2, lines 30-37. By providing two different documents, Prinzing asserts that software can be implemented in multiple computer systems without requiring the entire software application to be rewritten. Col. 1, line 64 to col. 2, line 4.

Prinzing is fundamentally different from the claimed invention in that it does not disclose or even relate to "providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data repository, each content object comprising a plurality of content entities," as recited in claim 1. In particular, Prinzing does not disclose or suggest that "some of the content entities being prerequisites to others of the content entities" such that "upon addition or removal of a content entity to or from the compilation, [it is determined whether] the content entity has any prerequisite content entities, and if so, . . . the prerequisite content entities [are added or removed]", as recited in claim 1.

To the contrary, Prinzing discloses a method and system that processes the content of a document separately from the information used to describe the structure of the content in the document. See Abstract. In Prinzing, a content entity 306 is capable of storing and manipulating (*e.g.*, inserting, deleting, retrieving, etc.) the content stored in a storage area 312. Col. 3, lines 35-37; col. 5, lines 35-42; and Fig. 3. A separate document entity 304 includes element entities 308, 310 to represent the structure of the document and reference the content stored by the content entity. Col. 3, lines 37-39; and Fig. 3. For example, element entity 308 and element entity 310 can be used to describe a text document having two paragraphs. Col. 5, lines 11-21.

Thus, Prinzing relates to separating the content storage and structural organization of a document because the integration of these functions in a single software module makes it difficult to replace the content storage routines without affecting other portions of the software application. Col. 1, lines 49-63. By facilitating the substitute of content storage routines, an application in Prinzing is able to use a set of content storage routines that is suited to the storage capacities of a particular data processing system running the application. Col. 2, lines 50-55; and Fig. 4.

The Examiner appears to take the position that the claimed prerequisite checking corresponds to Prinzing's comparing of a systems' storage capacity with storage characteristics of a default content entity. See Prinzing col. 2, lines 53-59. In particular, the Examiner alleges that Prinzing discloses the claimed features by describing that "the manipulation of content in the storage area includes inserting content in the content entity, removing content from the content entity . . ." and "the information retrieved from the element entities is used to manipulate the content stored in the storage area associated with the content entity," citing Prinzing col. 2, lines 21-67 and col. 3, lines 27-58 in support. In addition, the Examiner points to Prinzing disclosing that, "This determination is made by comparing the storage characteristics provided the default content entity and other content entities. Based on a result of this determination, the software application may replace the default content entity with a new content entity." Col. 2, lines 30-67. This, however, does not disclose "determining if the content entity has any prerequisite content entities, and if so, adding or removing the prerequisite content entities," as required by claim 1.

Even assuming *arguendo* that Prinzing discloses some type of prerequisite checking, Prinzing does not disclose all the elements of claim 1. For example, claim 1 recites "content entities being prerequisites to others of the content entities." Even if Prinzing is deemed to disclose checking prerequisites by "determining certain storage characteristics" it does not teach or suggest any "content entities being prerequisites to others of the content entities," much less "determining if the content entity has any prerequisite content entities," as recited in the claims.

The Examiner in addressing the claim limitations of determining if a content entity has any prerequisite content entities, cites col. 2, lines 21-67 and col. 3, lines 27-58 which states that "the manipulation of content in the storage area includes inserting content in the content entity, removing content from the content entity ... The information retrieved from the element entities is used to manipulate the content stored in the storage area associated with the content entity." However, it is respectfully submitted that those cited portions of Prinzing do not dislcose determining whether a content entity (i.e. text or alphanumeric data as cited by the Examiner) has any prerequisite content entities much less disclosing adding or removing the prerequisite content entities.

Because Prinzing fails to disclose or suggest any such prerequisite checking, claims 1, 6 and 11 are not anticipated by Prinzing. Consequently, claims 2-5, 7-10 and 12-15 are not anticipated by Prinzing, at least by virtue of their dependency.

2. Claims 2-5, 7-10 and 12-15 are patentable over Prinzing in view of Cousins *et al.*

Claims 2-5, 7-10 and 12-15 have been rejected under 35 U.S.C. § 103(a) as being anticipated by Prinzing in view of Cousins *et al.*

Claims 2-5, 7-10 and 12-15

Claims 2-5, 7-10 and 12-15 should be deemed patentable by virtue of their dependency to claims 1, 6 and 11 for at least the reasons set forth above. Moreover, Cousins does not cure the deficiencies of Prinzing.

Cousins is directed to a method and apparatus for detecting changes to a collection of objects. Cousins does not disclose the claimed prerequisite checking and consequently, does not cure the deficiencies of Prinzing.

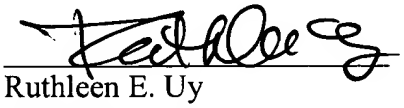
VIII. CONCLUSION

For the reasons set forth above, Appellant respectfully requests the members of the Board to reverse the rejections of the appealed claims and to find each of the claims allowable as defining subject matter that is patentable over the art of record.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: June 28, 2005

CLAIMS APPENDIX

CLAIMS 1-15 ON APPEAL:

1. A method for providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data repository, each content object comprising a plurality of content entities, some of the content entities being prerequisites to others of the content entities, comprising the steps of:

upon addition or removal of a content entity to or from the compilation, determining if the content entity has any prerequisite content entities, and if so, adding or removing the prerequisite content entities.

2. The method of claim 1, wherein one or more of the prerequisites are conditional.

3. The method of claim 1, wherein the conditions for applying a prerequisite are defined in one or more rules.

4. The method of claim 3, in the case of more than one rules pertaining to the same prerequisite, further comprising the step of reducing the rule set if possible into a smaller set of rules.

5. The method of claim 3, further comprising the step of rewriting any negative rules as positive rules.

6. A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform method steps for providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data

repository, each content object comprising a plurality of content entities, some of the content entities being prerequisites to others of the content entities, comprising the steps of:

upon addition or removal of a content entity to or from the compilation, determining if the content entity has any prerequisite content entities, and if so, adding or removing the prerequisite content entities.

7. The method of claim 6, wherein one or more of the prerequisites are conditional.

8. The method of claim 6, wherein the conditions for applying a prerequisite are defined in one or more rules.

9. The method of claim 8, in the case of more than one rules pertaining to the same prerequisite, further comprising the step of reducing the rule set if possible into a smaller set of rules.

10. The method of claim 8, further comprising the step of rewriting any negative rules as positive rules.

11. A system for providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data repository, each content object comprising a plurality of content entities, some of the content entities being prerequisites to others of the content entities, comprising:

means for determining, upon addition or removal of a content entity to or from the compilation, if the content entity has any prerequisite content entities, and if so, adding or removing the prerequisite content entities.

12. The system of claim 11, wherein one or more of the prerequisites are conditional.

13. The system of claim 11, wherein the conditions for applying a prerequisite are defined in one or more rules.

14. The system of claim 13, further comprising means for reducing the rule set if possible into a smaller set of rules in the case of more than one rules pertaining to the same prerequisite.

15. The system of claim 13, further comprising means for rewriting any negative rules as positive rules.

EVIDENCE APPENDIX:

NONE.

RELATED PROCEEDINGS APPENDIX

NONE.